

REMARKS

This response is being filed within three months of the Office Action dated June 9, 2005.

Claims 16-19, 27-31 and 33-39 are pending in the application. Claims 16, 27, 31, 36 and 39 are in independent form. Claim 39 has been amended to be in independent form. Applicant requests the fee for the one additional independent claim be withdraw from Applicant's Deposit Account 08-2025.

In the Office Action dated June 9, 2005, the Examiner states that claims 27-30 and 36-38, including independent claims 27, 31 and 36, are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Matsui et al. (U.S. Patent No. 5,896,143) in view of Snyder (U.S. Patent No. 4,840,284). In particular, the Examiner states that it would have been obvious to combine the bottom wall and the upwardly and outwardly extending tapered wall of Snyder with the upright side wall of Matsui. Applicant respectfully disagrees.

Matsui discloses:

"the previous discharge receiving portions (the previous discharge holes) 30 and 31 accommodate the ink holding members (for example, ink absorbers) 32. The ink holding member 32 may be, for example, a hydrophilic foaming agent or unwoven fabric. However, materials capable of holding the ink may be widely employed." (Matsui, FIG. 15 and column 19, lines 19-26) (emphasis added).

Accordingly, ink spit into discharge receiving portion 30 of Matsui is held in portion 30 by ink absorbers 32 and is not drained out of the bottom of discharge receiving portion 30.

In contrast, Snyder discloses a sloped bottom tank having "a bottom plate 16 [including] creases 24 and 26 directed toward discharge opening 28." (Snyder, FIG. 2 and column 2, lines 29-32). The object of Snyder's sloped bottom tank is "to provide a portable tank having a sloped bottom structure that presents a smooth interior surface sloped toward the discharge opening to allow full drainage from the tank." (Snyder, column 1, lines 33-37) (emphasis added).

The mere fact that the cited references can be combined or modified is not sufficient to establish *prima facie* obviousness; the prior art must provide the motivation for the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Matsui teaches structure for retaining fluid whereas Snyder teaches structure for draining fluid. In particular, one skilled in the art looking to modify the ink retaining capabilities of Matsui would not look to a fluid draining structure like that of Snyder. Similarly, one skilled in the art looking to modify the fluid draining capabilities of Snyder would not look to a fluid retaining structure like that of Matsui. Moreover, neither Matsui nor Snyder address Applicant's motivation for its structural design, namely, accumulating

two ink formulations in a single container. Accordingly, Matsui and Snyder, either alone or in combination, do not teach or suggest motivation for the combination. See *re Mills*.

Moreover, there is no suggestion or motivation to make the proposed modification because the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In particular, combining the sloped bottom and drainage hole of Snyder would render the fluid retaining container of Matsui unsatisfactory for its intended purpose of retaining fluid.

The Examiner has not met his burden of *prima facie* obviousness because Matsui and Snyder, either alone or in combination do not teach or suggest motivation for combining the references. In *re Mills*. Additionally, the Examiner has not met his burden of *prima facie* obviousness because even if Matsui and Snyder were combined, the resultant combination would not satisfy the intended purpose of the fluid retaining function of Matsui. In *re Gordon*. Applicant submits that independent claims 27, 31 and 36, and corresponding rejected claims 28-30, 37-38, are allowable under 35 U.S.C. 103(a) over Matsui in view of Snyder and Applicant respectfully requests allowance of the same.

In the Office Action dated June 9, 2005, the Examiner states that independent claim 31 and corresponding

dependent claims 33-35 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Matsui in view of Snyder and Osborne et al. (U.S. Patent No. 5,712,668). In particular, the Examiner states that it would have been obvious to combine the small sized bottom wall of Osborne with the teachings of Matsui and Snyder. Applicant respectfully disagrees.

As stated above, there is no teaching or suggestion of motivation to combine Matsui and Snyder because the two patents have very different objectives, i.e., Matsui teaches retaining fluid within an ink absorbing material and Snyder teaches draining fluid through a drainage hole in a tank. See *In re Mills*. Moreover, if Matsui and Snyder were combined, the modified container of Matsui would not satisfy the intended fluid retaining purpose of Matsui. See *In re Gordon*. Accordingly, the Examiner has not met his burden of *prima facie* obviousness.

Furthermore, there is no teaching or suggestion of combining Matsui and Osborne because neither Matsui nor Osborne teach a motivation for modifying Matsui to include a small sized bottom wall of Osborne positioned beneath the ink absorbing material of Matsui. There is no teaching or suggestion of combining Snyder and Matsui because neither Snyder nor Osborne teach a motivation for modifying Snyder because a small sized bottom wall of Osborne would render the tank of Snyder unstable, i.e., legs 20 of Snyder would not be positioned at an outer edge of the large draining

tank. Moreover, FIG. 8 of Osborne cited by the Examiner is merely a prior art figure which is not discussed by Osborne.

Applicant believes that there is no suggestion to combine Matsui, Snyder and Osborne, and, therefore, independent claim 31, and corresponding rejected claims 33-35, are allowable under 35 U.S.C. 103(a) over Matsui in view of Snyder and Osborne and Applicant respectfully requests allowance of the same.

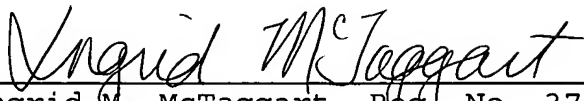
Applicant notes that the Examiner has allowed claims 16-19.

In the Office Action dated June 9, 2005, the Examiner stated that claim 39 would be allowable if rewritten in independent form. By this response Applicant has amended claim 39 to incorporate the limitations of independent claim 36. Accordingly, Applicant believes that claim 39 is in condition for allowance and respectfully requests the same.

Conclusion

If the Examiner should have any questions regarding this response, a call to Applicant's counsel, Ms. Ingrid M. McTaggart at (503) 230-7934, is respectfully requested. If the Examiner should have any other questions regarding the above referenced application, a call to Applicant's counsel Mr. Robert D. Wasson at (360) 212-2338, is respectfully requested.

Respectfully submitted,


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